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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LIN, KELVIN Y

ART UNIT PAPER NUMBER

2142

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,626

Applicant(s)

HAINES ET AL.

Examiner

Kelvin Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-16, 18-23 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16, 18-23, 25-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Withdrawal of Finality of Last Office Action

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Response to Arguments

1. Applicant's arguments, see Remarks from page 9 to 18, filed on Oct. 17, 2006, with respect to the rejection(s) of claim(s) 1-8, 10-16, 18-23, and 25-35 under 35 USC 103(a) as the combination of Moshir et al. in view of O'Toole et al. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Chang et al., (USPGPUB 2002/0059415).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-8, 10-16, 18-23, 25-35 are rejected under 35 U.S.C 102(e) as being anticipated by Chang et al., (USPGPUB 2002/0059415)
2. Regarding claim 1, Chang teaches a method of configuring a hard copy output engine comprising:
 - receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall, (Chang, [0197], fig. 8a-g, user receives an email at apparatus 100, including the email application of printing function and the output engine configuration),
 - configuring the hard copy output engine using the configuration data (Chang, [0206]).
3. Regarding claim 2, Chang further discloses the method of claim 1, wherein receiving the electronic message comprises receiving an email at the hard copy output engine (Chang, [0197], received the email at information apparatus 100, including output manager corresponding to the output engine), and wherein configuring comprises configuring the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data (Chang, fig.3, element 302, internet browsing

application corresponding to embedded web server contained in the apparatus 100).

4. Regarding claim 3, Chang further discloses the method of claim 1, wherein receiving the electronic message comprises receiving an email (Chang, [0197]).
5. Regarding claim 4, Chang further discloses the method of claim 1, wherein receiving the electronic message comprises:
 - receiving an email through the firewall at a first user station (Chang, [0207], the security verification and authentication corresponding to the firewall); and
 - forwarding the email to the hard copy output engine (Chang , [0201]).
6. Regarding claim 5, Chang further discloses the method of claim 1, wherein receiving the electronic message comprises receiving an XML script (Chang, [0101]), and configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed (Chang,[0202] 1.9-10, i.e. the estimation of time of operation, and [0204]).
7. Regarding claim 6, Chang further discloses the method of claim 1, wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers (Chang, [0022]).
8. Regarding claim 7, Chang further discloses the method of claim 1, wherein the

configuration data include data prepared by: determining a make and model for the hard copy output engine (Chang, [0006]); determining a serial number for the hard copy output engine; and determining user thresholds for consumables associated with the hard copy output engine (Chang, [0067]).

9. Regarding claim 8, Chang further discloses an apparatus comprising:
 - a device configured to provide a computer instruction signal embodied in a carrier wave carrying instructions (Chang, fig. 1, element 100) that when executed by a processor cause the processor to: receive an electronic message including hard copy output engine configuration data from an undesignated website through a firewall (Chang, fig. 2a-b, and 3a-c) and configure the hard copy output engine using the configuration data, wherein the computer instruction signal embodied in the carrier wave carrying instruction that cause the processor to receive an electric message includes a computer instruction signal embodied in the carrier wave carrying instruction (Chang, fig. 8a-g) that cause the processor to receive an email at the hard copy output engine (Chang, fig. 3a-c), and wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure comprises a computer instruction signal embodied in the carrier wave carrying instruction that cause the processor to configure the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data (Chang, fig. 8a-g) .

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10. Regarding claims 10-13 claiming for apparatus have limitations corresponding to claims 1-6. Therefore, Claims 10-13 are rejected for the same reasons set forth in the rejection of method claims 1-6.
11. Regarding claims 14-16, 18-20 claiming for the system have limitations corresponding to apparatus claims 8, and 10-13. Therefore, Claims 14-16, 18-20 are rejected for the same reasons set forth in the rejection of claims 8, and 10-13
12. Regarding claims 21-23, 25-26 claiming for computer usable medium have similar limitations as claims 8, and 10-13. Therefore, Claims 21-23, 25-26 are rejected for the same reasons set forth in the rejection of claims 8, and 10-13.
13. Regarding claims 27-35 claiming for the firewall have limitations corresponding to claims 8, and 10-13. Therefore, Claims 27-35 are rejected for the same reasons set forth in the rejection of claims 8, and 10-13.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelvin Lin whose telephone number is 571-272-3898. The examiner can normally be reached on Flexible 4/9/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10/30/06
KYL



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PATENT EXAMINER